

REMARKS

The present claims are 1-3, 5, 7, 15-19 and 27. The claims have been amended to read on the elected species, i.e. 3-(5-Dimethylamino-3H-isobenzofuran-1-ylidene)-1-piperidin-1-ylmethyl-1,3-dihydro-indol-2-one.

Claim 27 is newly added in response to the Examiner's rejection of Claim 1 under 35 USC 112, second paragraph, for indefiniteness.

The Examiner has rejected Claim 1 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that "in reference to 'R3 and R4' the definition should be clarified because the way that the claim is currently recited, one may interpret the phrase 'R3 and R4', together with the nitrogen atom may form a cyclic ring, which ring may be substituted with said heteroatoms" to mean the formed ring will be substituted with said heteroatoms, or that one or more atoms of the formed ring is substituted with a heteroatom. The Examiner goes on to illustrate why this is indefinite. "In the first interpretation, the ring is limited to a ring containing one heteroatom (the nitrogen). In the second interpretation, the many heterocyclic rings may be formed (e.g. morpholine)." Note that the Examiner cites morpholine as an example of his second interpretation and morpholine is, indeed, specifically called out in claim 4 as an example of a cyclic ring which "together with the nitrogen atom may form a cyclic ring."

The Examiner also states that Claim 1 is also indefinite "because the claim fails to distinctly and particularly point out the how many members make up the cyclic ring. Is it a 4, 5 or 6 member ring?" This rejection is incorrect since there is no reason why the ring can't have any of 4, 5 or 6 members and any of said heteroatoms can be combined with the nitrogen atom specifically set out in formula III to form a ring having 4, 5, 6 or more members. Nevertheless, this rejection is now moot in regards to claim 1 since this claim has been amended, in view of the election of the species of Example 19 to require that the ring is piperidinyl, only.

Claim 27 has been added to clearly point out that the applicants are claiming compounds wherein R³ and R⁴, together with the nitrogen atom of formula III can form a ring of many members, i. e. 4, 5, 6, or more, and one or more of those members may be

one of the cited heteroatoms, i. e. nitrogen, sulfur, or oxygen. (Or the heteroatoms may be bonded to a ring atom, e. g. halogen.) This interpretation would be understood by one of ordinary skill in the art by reference to claims 4 and 5 wherein the ring may have 5 or 6 members and may include a heteroatom such as oxygen, i. e. morpholinyl.

In view of the above, it is believed that claim 1 was not and now claim 27 is not indefinite since it is clear that by reading claim 1 or 27 in view of claims 4 and 5 one would conclude that the ring may have many members and some of said members may include oxygen, sulfur and an additional nitrogen atom in the ring. Moreover, said rings can be substituted, in particular with halogen, which atom could not be included as a heteroatom which makes up the ring itself.

The Examiner has also rejected Claim 1 as being indefinite in reciting the variable "e" as an integer from 2 to 5. As the Examiner correctly points out, Formulae (II) and (III) do not contain the variable "e". The applicants have amended claim 1 to cancel the variable "e" and "e" is now set out in claim 2. In claim 2, the variable "e" appears as one of the variables which are included in the definition of R.

Similarly, the Examiner's rejection of Claim 2 under 35USC 112, second paragraph (for reciting the limitation "e" in the definition for "R") as lacking "antecedent basis because claim 1 does not contain the variable "e" is overcome by this amendment. As now amended, there is no requirement for "e" being dependent on claim 1 since "e" does not appear in amended claim 1.

Finally, the applicants have moved the definition of R⁸ and R⁹ from claim 2 to claim 1 where the elements R⁸ and R⁹ are first cited.

Thus, claim 1 and new claim 27 are now in compliance with the requirements of 35 USC 112, second paragraph.

The Examiner has rejected Claims 1-5, 7, 15-19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent 6,699,863. The Examiner has invited the applicants to file a Terminal Disclaimer to overcome this double patenting rejection. This has now been done to overcome this rejection.

The applicants would like to comment on one statement the Examiner made in his double patenting rejection. The Examiner states that "there is no apparent reason why applicant was prevented from presenting claims corresponding to the use of the instant

application during prosecution of the application". It is clear that the inventors named in the "683 Patent are not the inventors of the present claims. Therefore the present claims could not have been made in the "683 Patent.

The Examiner has required that the applicants delete the non-elected subject matter from claim 1, 4 and 5. This has now been done to overcome this rejection.

It is believed that the claims, as now amended, are in condition for allowance. The Examiner is requested to withdraw the rejections of record and pass the claims to issue.

Please charge Deposit Account 01-0885 for any fee required with this Response.

Respectfully Submitted,

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